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EXAMINER

HONEYCUTT, KRISTINA B

ART UNIT PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,664	Applicant(s) STUPLE ET AL.	
	Examiner Kristina B. Honeycutt	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed September 23, 2003.

This action is made **Non-Final**.

2. Claims 1-45 are pending in the case. Claims 1, 9, 17, 23, 30 and 38 are independent claims.

Drawings

3. The drawings filed on September 23, 2003 are accepted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 30 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1 recites the limitation "the location" in line 19. There is insufficient antecedent basis for this limitation in the claim. Claim 30 is rejected along the same rationale.

6. Claim 38 recites the limitation "the other location" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is not tangibly embodied as to be executable.

The language of claims 9-16 raises a question as to whether the claimed modules are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. §101.

See MPEP §2106 below.

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1. Nonstatutory Subject Matter

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

In practical terms, claims define nonstatutory processes if they:

- consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

- simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

Cf. *Alappat*, 33 F.3d at 1543 n.19, 31 USPQ2d at 1556 n.19 in which the Federal Circuit recognized the confusion:

The Supreme Court has not been clear . . . as to whether such subject matter is excluded from the scope of 101 because it represents laws of nature, natural phenomena, or abstract ideas. See *Diehr*, 450 U.S. at 186 (viewed mathematical algorithm as a law of nature); *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972) (treated mathematical algorithm as an "idea"). The Supreme Court also has not been clear as to exactly what kind of mathematical subject matter may not be patented. The Supreme Court has used, among others, the terms "mathematical algorithm," "mathematical formula," and "mathematical equation" to describe types of mathematical subject matter not entitled to patent protection standing alone. The Supreme Court has not set forth, however, any consistent or clear explanation of what it intended by such terms or how these terms are related, if at all.

Certain mathematical algorithms have been held to be nonstatutory because they represent a mathematical definition of a law of nature or a natural phenomenon. For example, a mathematical algorithm representing the formula $E = mc^2$ is a "law of nature" - it defines a "fundamental scientific truth" (i.e., the relationship between energy and mass). To comprehend how the law of nature relates to any object, one invariably has to perform certain steps (e.g., multiplying a number representing the mass of an object by the square of a number representing the speed of light). In such a case, a claimed process which consists solely of the steps that one must follow to solve the mathematical representation of $E = mc^2$ is indistinguishable from the law of nature and would "preempt" the law of nature. A patent cannot be granted on such a process.

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships

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between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9, 30 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux et al. (U.S. Pub. No. 20040243574; publication date December 2, 2004; filed July 1, 2004; continuation of application filed July 20, 2000) in view of Nolan et al. (U.S. Pub. No. 20020091776; publication date July 11, 2002; filed October 16, 2001).

Regarding independent claim 1, Giroux teaches determining a first set of format attributes associated with a first region of content for the electronic document, wherein the first region of content comprises a source for a portion of content (Figure 2; p.2, para. 38, 45, 47, 48; p.4, para. 69) since Giroux teaches extracting data from a source in a source's format.

Giroux further teaches determining a second set of format attributes associated with a second region of content for the electronic document, wherein the second region of content comprises a destination for the portion of content (Figure 2; p.2, para. 38, 45; p.4, para. 74) since Giroux teaches converting content to a destination's format.

Giroux further teaches applying to the portion of content those format attributes of the second set of format attributes in response to placing the portion of content at the location (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74) since Giroux teaches converting source content to a destination's format when the content is pasted. Giroux does not disclose comparing the first set of format attributes with the second set of format attributes and applying the format attributes if they differ from the first set. Nolan teaches comparing formats and converting the format if they are different (p.2, para. 10). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Nolan before him at the time the invention was made, to modify converting formats as taught by Giroux to include comparing the formats and converting if the formats are different as taught by Nolan, because Giroux teaches converting a source format to a destination format (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74)

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and Nolan teaches converting formats if a comparison shows that the formats differ (p.2, para. 10).

Regarding independent claim 9, Giroux teaches a copy module, logically coupled to a format module, operable to place a portion of content at a destination for the portion of content in the electronic document (p.2, para. 47) since Giroux teaches copying source content to a destination with the destination's format applied to the content.

Giroux further teaches a format module, operable to determine a first set of format attributes associated with a first region of content for the electronic document, wherein the first region of content comprises a source for a portion of content (Figure 2; p.2, para. 38, 45, 47, 48; p.4, para. 69) since Giroux teaches extracting data from a source in a source's format, further operable to determine a second set of format attributes associated with a second region of content for the electronic document, wherein the second region of content comprises a destination for the portion of content (Figure 2; p.2, para. 38, 45; p.4, para. 74) since Giroux teaches converting content to a destination's format, further operable to apply to the portion of content those format attributes of the second set of format attributes in response to placing the portion of content at the location (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74) since Giroux teaches converting source content to a destination's format when the content is pasted.

Giroux does not disclose comparing the first set of format attributes with the second set of format attributes and applying the format attributes if they differ from the first set. Nolan teaches comparing formats and converting the format if they are

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different (p.2, para. 10). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Nolan before him at the time the invention was made, to modify converting formats as taught by Giroux to include comparing the formats and converting if the formats are different as taught by Nolan, because Giroux teaches converting a source format to a destination format (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74) and Nolan teaches converting formats if a comparison shows that the formats differ (p.2, para. 10).

Regarding independent claims 30 and 38, the claims reflect the computer-implemented method and computer-readable storage device for performing the operations of claim 1 and are rejected along the same rationale.

9. Claims 2, 3, 8, 10, 11, 16, 17, 31, 32, 37, 39, 40 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Bailey et al. (U.S. Pub. No. 20050188307; publication date August 25, 2005; filed April 25, 2005; continuation of application filed June 7, 2001).

Regarding dependent claim 2, which depends on claim 1, Giroux does not disclose determining if any of the portion of content contains direct formatting attributes, based on the first set of format attributes and applying the direct formatting attributes to the portion of content based on the second set of format attributes. Bailey teaches determining and applying direct formatting properties to content (p.1, para. 3; p.3, para.

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34; p.4, para. 42). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Bailey before him at the time the invention was made, to modify applying formats as taught by Giroux to include applying direct formatting as taught by Bailey, because Giroux teaches applying format attributes to content (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74) and Bailey teaches applying direct formatting properties to content (p.1, para. 3; p.3, para. 34; p.4, para. 42).

Regarding dependent claim 3, which depends on claim 2, Giroux does not disclose the step of applying the direct formatting attributes further comprises the step of determining a format attribute to apply to the portion of content containing direct formatting attributes, wherein the determined format attribute provides emphasis for the portion of content containing direct formatting attributes. Bailey teaches determining and applying direct formatting properties to the content that provide emphasis (p.1, para. 3; p.3, para. 34; p.4, para. 42). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Bailey before him at the time the invention was made, to modify applying formats as taught by Giroux to include applying direct formatting that provides emphasis as taught by Bailey, because Giroux teaches applying format attributes to content (Figure 2; p.2, para. 38, 45, 47; p.4, para. 69, 74) and Bailey teaches applying direct formatting properties that provide emphasis to content (p.1, para. 3; p.3, para. 34; p.4, para. 42).

Regarding dependent claim 8, which depends on claim 1, Giroux does not disclose recording the first set of format attributes, in response to determining the first set of format attributes and recording the second set of format attributes, in response to determining the second set of format attributes. Bailey teaches recording format properties (p.3, para. 35). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Bailey before him at the time the invention was made, to modify determining formats as taught by Giroux to include recording formatting properties as taught by Bailey, because Giroux teaches determining format attributes (Figure 2; p.2, para. 38, 45, 47, 48; p.4, para. 69) and Bailey teaches recording the determined formatting properties (p.3, para. 35).

Regarding dependent claims 10 and 31, the claims reflect the system and computer-implemented method for performing the operations of claim 2 and are rejected along the same rationale.

Regarding dependent claims 11, 32 and 40, the claims reflect the system, computer-implemented method and computer-readable storage device for performing the operations of claim 3 and are rejected along the same rationale.

Regarding dependent claims 16, 37 and 45, the claims reflect the system, computer-implemented method and computer-readable storage device for performing the operations of claim 8 and are rejected along the same rationale.

Regarding independent claim 17, the claim reflects the computer-implemented method for performing the operations of claims 1, 2 and 8 and is rejected along the same rationale.

Regarding dependent claim 39, the claim reflects the computer-readable storage device for performing the operations of claims 2 and 17 and is rejected along the same rationale.

10. Claims 4-6, 12-14, 34, 35, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Sciammarella et al. (U.S. Patent 6570582; date of patent May 27, 2003; filed February 4, 2000).

Regarding dependent claim 4, which depends on claim 1, Giroux teaches cutting and pasting content (p.1, para. 26). Giroux does not disclose the first region of content comprises a first plurality of paragraphs within a first number of lines from the portion of content to be cut and the second region of content comprises a second plurality of paragraphs within a second number of lines from the location into which the portion of content to be cut is to be pasted. Sciammarella teaches cutting and pasting paragraphs (col. 6, lines 16-18). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Sciammarella before him at the time the invention was made, to modify cutting and pasting content as taught by Giroux to include cutting

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and pasting paragraphs as taught by Sciammarella, because Giroux teaches cutting and pasting content (p.1, para. 26) and Sciammarella teaches cutting and pasting paragraphs (col. 6, lines 16-18).

Regarding dependent claim 5, which depends on claim 1, Giroux teaches regions of content (p.2, para. 38, 45, 47) but does not disclose the first region of content comprises a first paragraph and the second region of content comprises a second paragraph. Sciammarella teaches paragraphs (col. 6, lines 16-18). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Sciammarella before him at the time the invention was made, to modify the content taught by Giroux to include paragraphs as taught by Sciammarella, because Giroux teaches performing operations on regions of content (p.2, para. 38, 45, 47) and Sciammarella teaches performing the same operations on content in paragraph form (col. 6, lines 16-18).

Regarding dependent claim 6, which depends on claim 1, Giroux teaches copying and pasting content (p.2, para. 47). Giroux does not disclose the first region of content comprises a first plurality of paragraphs within a first number of lines from the portion of content to be copied and the second region of content comprises a second plurality of paragraphs within a second number of lines from the location into which the portion of content to be copied is to be pasted. Sciammarella teaches copying and pasting paragraphs (col. 6, lines 16-18). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Sciammarella before him at the time the

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invention was made, to modify copying and pasting content as taught by Giroux to include copying and pasting paragraphs as taught by Sciammarella, because Giroux teaches copying and pasting content (p.2, para. 47) and Sciammarella teaches copying and pasting paragraphs (col. 6, lines 16-18).

Regarding dependent claims 12 and 41, the claims reflect the system and computer-readable storage device for performing the operations of claim 4 and are rejected along the same rationale.

Regarding dependent claims 13, 34 and 42, the claims reflect the system, computer-implemented method and computer-readable storage device for performing the operations of claim 5 and are rejected along the same rationale.

Regarding dependent claims 14, 35 and 43, the claims reflect the system, computer-implemented method and computer-readable storage device for performing the operations of claim 6 and are rejected along the same rationale.

11. Claims 7, 15, 36 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Bennett et al. (U.S. Patent 5940800; date of patent August 17, 1999; filed August 31, 1998).

Regarding dependent claim 7, which depends on claim 1, Giroux teaches copying and pasting content (p.2, para. 47) but does not disclose the first region of content comprises a first plurality of content associated with a first level in one or more outline objects comprising the portion of content to be copied and the second region of content comprises a second plurality of content associated with a second level in one or more outline objects comprising the location into which the portion of content to be copied is to be pasted. Bennett teaches copying and pasting content in an outline (col. 12, lines 21-23). It would have been obvious to one of ordinary skill in the art, having the teachings of Giroux and Bennett before him at the time the invention was made, to modify copying and pasting content as taught by Giroux to include copying and pasting outlines as taught by Bennett, because Giroux teaches copying and pasting content (p.2, para. 47) and Bennett teaches copying and pasting outlines (col. 12, lines 21-23).

Regarding dependent claims 15, 36 and 44, the claims reflect the system, computer-implemented method and computer-readable storage device for performing the operations of claim 7 and are rejected along the same rationale.

12. Claims 18-21, 23-27, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Bailey in further view of Sciammarella.

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Regarding dependent claims 18, 27, the claims reflect the methods for performing the operations of claim 6 and are rejected along the same rationale.

Regarding dependent claims 19, 21, 25 and 33, the claims reflect the methods for performing the operations of claim 4 and are rejected along the same rationale.

Regarding dependent claims 20, 26, the claims reflect the methods for performing the operations of claim 5 and are rejected along the same rationale.

Regarding independent claim 23, the claim reflects the computer-implemented method for performing the operations of claims 1, 2 and 6 and is rejected along the same rationale.

Regarding dependent claim 24, the claim reflects the method for performing the operations of claim 3 and is rejected along the same rationale.

Regarding dependent claim 29, the claim reflects the method for performing the operations of claim 8 and is rejected along the same rationale.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Bailey in further view of Bennett.

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Regarding dependent claim 22, the claim reflects the method for performing the operations of claim 7 and is rejected along the same rationale.

14. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Nolan in further view of Bailey in further view of Sciammarella in further view of Bennett.

Regarding dependent claim 28, the claim reflects the method for performing the operations of claim 7 and is rejected along the same rationale.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Method and system for mapping non-uniform table-structure input data to a uniform cellular data structure (U.S. Patent 5881381),
- Schema-based file conversion (U.S. Pub. No. 20020174135).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristina B. Honeycutt whose telephone number is 571-272-4123. The examiner can normally be reached on 8:00 am - 5:00 pm Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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PRIMARY EXAMINER